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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,158	07/25/2006	Kazumi Morimoto	10921.416USWO	4989

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EXAMINER

INGHAM, JOHN C

ART UNIT	PAPER NUMBER
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2814

MAIL DATE	DELIVERY MODE
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11/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,158	Applicant(s) MORIMOTO ET AL.	
	Examiner JOHN C. INGHAM	Art Unit 2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/25/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims **1-3** are rejected under 35 U.S.C. 102(b) as being anticipated by JP10-74962.

3. Regarding claims **1 and 2**, JP10-74962 discloses in Fig 1 a light receiving module comprising: a light receiving element (13), an IC chip (14), a light permeable and electrically insulating sealing member (11) for sealing the light receiving element and the IC chip, a convex lens (23) provided at a surface of the sealing member facing the light receiving element, and a light impermeable and electroconductive coating (24) for covering the sealing member with the lens exposed, the coating being connected to ground (¶32 of machine translation), wherein the coating is provided with a vertical wall (vertical surfaces of hole 21) made up of an electroconductive member and surrounding the lens, wherein the vertical wall has a height greater than a height of the lens in a thickness direction of the lens.

4. Regarding claim **3**, JP10-74962 discloses in Fig 7 the module of claim 2, wherein the vertical wall (vertical surfaces of item 54) includes an inner surface for reflecting light (metal plate), the inner surface being inclined in a manner such that an inner diameter

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of the vertical wall is reduced as proceeding toward a bottom (opening is wider at top of lens).

5. Claims **1 and 4** are rejected under 35 U.S.C. 102(b) as being anticipated by JP 09-084162.

6. Regarding claims **1 and 4**, JP 09-084162 discloses in Fig 1C a light receiving module comprising: a light receiving element (2), an IC chip (3), a light permeable and electrically insulating sealing member (7) for sealing the light receiving element and the IC chip, a lens (7a) provided at a surface of the sealing member facing the light receiving element, and a light impermeable and electroconductive coating (8) made of resin for covering the sealing member with the lens exposed, the coating being connected to ground (abstract), wherein the coating is provided with a vertical wall (vertical surfaces around exterior of resin item 7) made up of an electroconductive member and surrounding the lens.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Horio (US 6,590,152 Fig 4) and Giebler (US 6,583,401 Fig 3A) each disclose limitations of claim 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN C. INGHAM whose telephone number is (571)272-8793. The examiner can normally be reached on M-F, 8am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (571) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Howard Weiss/
Primary Examiner
Art Unit 2814

John C Ingham
Examiner
Art Unit 2814

/J. C. I./
Examiner, Art Unit 2814